<u>REMARKS</u>

These remarks are responsive to the Office Action dated 03/13/2006 wherein claims 1-19 were rejected. Claims 1-19 are presently pending in this application.

<u>Claim rejections under 35 U.S.C. §103</u>

Claims 1-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent application 2002/0059347 A1 of Shaffer et al. (hereafter "<u>Shaffer</u>") in view of U.S. Patent No. 5,950,215 of Tabuchi. (hereafter "<u>Tabuchi</u>".) Applicant respectfully traverses.

<u>The Cited Art</u>

<u>Shaffer</u> describes a system and method for automatically loading an application program associated with an e-mail application attachment file upon reception of the e-mail. Alternatively, the application program may be loaded as soon as the e-mail message itself is opened, without waiting for the user to click on the attachment icon. In either case, the application program is loaded in a minimized state such that as soon as the user clicks on the attachment icon, the attachment application file may be run without waiting for the relatively lengthy time required to load the application program. Prior to loading the application program, responsive to receiving the e-mail message, the computer (102, 114) may examine system resources to determine whether memory (208) usage is sufficient to allow for the opening of the application program.

<u>Tabuchi</u> describes a compound document managing system which includes a compound document managing unit for embedding or linking data produced by an application in or with data produced by other applications and managing the data as a compound document. The application includes a context information managing unit for setting or releasing context information indicative of semantics common among a plurality of applications, and includes data distribution ranges, data presentation targets and data production source information, and history information, to or from data embedded in or linked with the compound document. Tthe system also includes a selection unit for selecting specific context information set to data to specify data corresponding to the selected context information. The compound document managing unit includes a control unit responsive to a request for setting or selecting context information to or

out of the data of the compound document for starting and controlling the context information managing unit and the selection unit of the application corresponding to the data.

The Prior Art Distinguished

Claim 1 was rejected over Shaffer in view of Tabuchi. Applicant respectfully submits that the Examiner has not made a *prima facie* showing of obviousness with respect to these two references. To establish a *prima facie* case, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 1 includes the limitation of "automatically retrieving code from a server over a network after an electronic message received over the network is opened for viewing by a user." Neither Shaffer or Tabuchi teach or suggest this limitation.

Shaffer teaches launching an application program that is stored and installed locally prior to the opening of an email. See for example:

> **This process is disadvantageous, however, in that the computer requires several seconds to load the application program prior to loading the attachment application file. For example, a 200 MHZ Pentium running Windows 95 may take approximately 5 seconds to load Word 95 prior to loading the attachment Word document. Accordingly, the user wastes time while the computer performs the loading task. [Shaffer, paragraph 0006]**

Shaffer is clearly teaching launching an application which is pre-loaded onto the user's computer. Receiving over a network, installing, and launching Word 95 would take considerably longer than the "5 seconds to load" contemplated by Shaffer. Further, since Shaffer is concerned with reducing the amount of time it takes to launch an application, Shaffer pointedly *teaches away* from automatically retrieving code from a server over a network after an electronic message received over the network is opened for viewing by a user.

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Tabuchi is silent with respect to Applicant's limitation of automatically retrieving code from a server over a network after an electronic message received over the network is opened for viewing by a user.

Therefore, the combination of Shaffer and Tabuchi does not teach or suggest all of the limitations of claims 1. Since the Examiner has failed to make a *prima facie* case of obviouness with respect to claim 1, for at least this reason, Applicant respectfully requests the withdrawal of the rejection of claim 1 and its dependent claims 2-11.

With respect to claim 12, the examiner states:

Claims 12 and 17 contain the similar limitations set forth of method claim 1. Therefore, claims 12,17 are rejected for the similar rationale set forth in claim 1. [Present Office Action, Page 3, item 5]

Since this is the only rejection in the present office action with respect to claim 12, and the examiner relies on the rejection of claim 1 discussed above, Applicant respectfully requests the withdrawal of the rejection of claim 12 and its dependent claims 16-19 for at least the reasons set forth above with respect to claim 1.

Regarding claim 13, the limitation "an application program object initialized, at least in part, by being automatically received, at least in part, over the network after the receipt and opening for viewing of the data object" is not taught by either Shaffer, Tabuchi, or any combination thereof.

The examiner paraphrases the claim, and in so doing, removes one or more limitations:

As per claims 7,13 Shaffer-Tabuchi disclose at least one code segment resides, at least in part, in a browser software as inherent feature of email application. [Present Office Action, page 4, item 11]

For comparison, Applicant's claim 13 is reproduced below:

An electronic message comprising: a data object including text that had been received over a network and stored on a computer having an electronic mail program; and an application program object initialized, at least in part, by being automatically received, at least in part, over the network after the receipt and

opening for viewing of the data object, the application program object being automatically executed on the computer after the initialization thereof. [Present Application, Claim 13]

The combination of <u>Shaffer</u> and <u>Tabuchi</u> does not teach the all of the limitations of claim 13. Applicant respectfully requests the withdrawal of the rejection of claim 13 and its dependent claims 14 and 15.
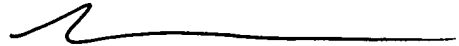
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Conclusion

All claims being allowable, Applicant respectfully requests an early Notice of Allowance. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, he is respectfully requested to call the undersigned at the number set forth below.

Respectfully submitted,

Date: 8/14/06

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